

REMARKS

Claims 1-18 are pending in the application, with claims 1 and 10 being in independent form.

Based on the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections, and that they be withdrawn.

Examiner Interview

Applicant's representative, Martin M. Zoltick, wishes to thank Examiner Chang for extending the courtesy of the telephonic interview held on April 22, 2004, and for the helpful and courteous discussions.

Claims 1-18 and the "SonicBox" system were discussed, as reflected in the Interview Summary. Specifically, with respect to the pending claims, the terms "broadcast" and "transmission medium" were discussed. The Examiner and Applicant's undersigned representative discussed clarification as to the definition of these terms. Applicant's representative noted that these terms were intended to be used and should be interpreted according to their ordinary and customary meaning within the art.

With respect to the term "broadcast," the ordinary and customary meaning within the art is set forth, for example, in *The Authoritative Dictionary of IEEE Standards Terms*, Seventh Edition (2000) as "a mode of information transfer in which a single message is transmitted simultaneously to multiple receivers." See Exhibit A. As described in the subject application: "First, the fulfillment system broadcasts information corresponding to purchasable items to a plurality of consumers. This simple approach enables the fulfillment system to make many offers to many consumers at the same time. Unlike traditional delivery systems where the consumer initiates the shopping session, the fulfillment system provides information relating to purchasable items to consumers without any consumer interaction." Application, page 7, lines 4-8 (emphasis supplied).

As noted above, the term "transmission medium" was also intended to be used and should be interpreted according to its ordinary and customary meaning within the art. The

ordinary and customary meaning of the term “transmission medium” is set forth, for example, in *The Authoritative Dictionary of IEEE Standards Terms*, Seventh Edition (2000), as “(1) A means for transporting electrical or optical signals.” See Exhibit B. The subject application includes the following disclosure: “Now, more than ever, consumers may choose from a plurality of transmission mediums to access the Internet, such as cable, telephone, satellite, or some other high speed connection. As more consumers gain access to the Internet through a multitude of available transmission mediums, things previously done in the real world are now available through the Internet using at least one of the transmission mediums.” Application, page 2, lines 8-12 (emphasis supplied). The application further discloses, for example, the use of “radio waves” (Application, page 6, line 8; page 8, lines 12-13), “cable” (Application, page 7, line 13), and “satellite” (Application, page 7, line 13). Applicant notes that the specification, in connection with providing various examples of the multiple transmission mediums suitable for use in the cross channel fulfillment and delivery system and method of the present invention, also describes broadcast and delivery systems, methods, and devices for broadcasting information to consumers on purchasable items and for delivering items to consumers using, for example, networks, like the internet (Application, page 2, line 9; page 12, line 10), software programs, like e-mail (Application, page 7, line 2; page 8, lines 20-21), and devices, like a set-top box and personal computer (Application, page 8, line 14; Fig. 1).

Claim Rejections – 35 U.S.C. § 102

In the Office Action, claims 1-8 and 10-16 are rejected under 35 U.S.C. § 102(a) as being anticipated by the system “SonicBox.” The applicant respectfully traverses this rejection. The claims are not anticipated by “SonicBox” because the SonicBox system fails to disclose all of the claimed features.

SonicBox discloses a device that connects to the internet through a standard PC. A feature of the device is that it receives music that is transmitted over the internet and then wirelessly broadcasts the music over a blank FM channel so that a user’s stereo equipment can receive the music by tuning to the blank FM channel. SonicBox also appears to

disclose that the user can purchase the song that the user is currently listening to by selecting a "Tell Me More" button. For example, an article about SonicBox states, "a 'Tell Me More' button ... can be used to ... purchase MP3 files or CDs."¹

The Office Action contends that "purchasing of MP3s inherently comprises the delivery of the item electronically via the Internet." Office Action, page 3 (emphasis added). However, in order to establish that the purchasing of MP3s inherently comprises the delivery of the item electronically via the Internet, the Office Action must provide evidence that purchasing of MP3s necessarily involves delivery via the Internet. See *M.P.E.P. Section 2112* ("In relying upon the theory of inherency, the Office Action must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.") (citations omitted) (emphasis in the original). "Inherency, however, may not be established by probabilities or possibilities." *Id.* Accordingly, the fact that it may be possible to deliver MP3s over the internet does not mean that a purchased MP3 is inherently (i.e., necessarily) delivered via the Internet. In fact, MP3s can be burned onto a CD and the CD can be delivered via UPS or FedEx. That is, it is not necessary to deliver all MP3s via the Internet. Hence, because the Office Action has not provided any facts and/or technical reasoning to support the contention that a purchased MP3 file is necessarily delivered via the Internet, the Office Action has not established its theory of inherency.

Even if the Office Action's theory of Inherency is accepted, the SonicBox disclosures do not anticipate claim 1. Claim 1 does not read on SonicBox. That is, SonicBox does not include all of the features required by claim 1. For example, SonicBox, does not disclose a method comprising, among other steps, the steps of:

- (1) "receiving ... a message broadcast from a fulfillment system ..., the message identifying an item for delivery in electronic form ..., wherein the broadcast message is transmitted ... using a first transmission medium," and

¹ J. Partyka, "Sonicbox bring Net Radio into your living room," www.cnn.com/TECH/computing/9910/12/sonic.box.idg/

- (2) “delivering ... the item requested for purchase by the consumer using a second transmission medium ..., wherein the second transmission medium *is different* than the first transmission medium”

as is recited in claim 1.

Assuming the Office Action’s inherency argument is correct and, assuming further, that the claimed broadcast message reads on the music streamed via the broadband connection thru the internet to the SonicBox system, then claim 1 is not anticipated because the streamed music and the purchased MP3 are transmitted using the same transmission medium – i.e., the broadband connection --, not different transmission mediums as required by claim 1. More specifically, the purchased MP3 is delivered via the broadband connection thru the internet to the user’s PC and the streamed music received by the SonicBox is also delivered via the same broadband connection thru the internet to the user’s same PC. Hence, the transmission mediums are exactly the same. As explained above, claim 1 requires different transmission mediums. Accordingly, even assuming the Office Action’s theory of inherency and that the claimed broadcast message reads on the music streamed to the SonicBox, the SonicBox disclosures would still not anticipate claim 1.

Furthermore, assuming that the claimed “broadcast message” reads on the music broadcast by the SonicBox to the user’s stereo equipment, claim 1 is still not anticipated. Claim 1 requires that the device that receives the broadcast message receive it from the fulfillment system and be the same device that transmits the purchase request to the fulfillment system. More specifically, claim 1 requires the steps of: (1) “receiving at [a] remote device a message from a fulfillment system,” and (2) “transmitting information from the particular remote device to the fulfillment system, wherein the transmitted information reflects the received instruction.” In the SonicBox system, the user’s stereo equipment does not receive the music from a fulfillment system, rather it receives it from the SonicBox device attached to the user’s PC. Moreover, the user’s stereo equipment does not transmit anything, let alone transmit the purchase request to the fulfillment system. Rather, in the SonicBox system, the purchase request is transmitted from the

user's PC to the fulfillment system. Hence, even if the claimed "broadcast message" reads on the music broadcast by the SonicBox to the user's stereo equipment, claim 1 is still not anticipated.

With respect to claim 10, the above remarks for claim 1 apply because claim 10 includes the same elements discussed above with respect to claim 1. For example, like claim 1, claim 10 requires transmitting a broadcast message to a remote device and receiving purchase requests from the remote device. Additionally, like claim 1, claim 10 requires that the broadcast message be transmitted using a broadcast transmission medium and further requires that the purchased items are transmitted using a transmission medium different from the broadcast transmission medium used to transmit the broadcast message. Accordingly, claim 10 is not anticipated for at least the same reasons given above with respect to claim 1.

With respect to claim 2-9 and 11-18, these claims depend from claims 1 and 10, respectively. Hence they are patentable for at least the same reasons given above with respect to claims 1 and 10.

Claim Rejections – 35 U.S.C. § 103

In the Office Action, claims 9, 17, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the system "SonicBox" as applied in claims 1 and 10. The applicant respectfully traverses this rejection. Claims 9, 17, and 18, which depend from claims 1 and 10, are patentable for at least the same reasons given above with respect to claims 1 and 10.


CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections, and that they be withdrawn.

Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the

Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Favorable consideration of this application is respectfully requested.

RESPECTFULLY SUBMITTED,					
NAME AND REG. NUMBER	Martin M. Zoltick, Registration No.: 35,745 Brian Rosenbloom, Registration No.: 41,276				
SIGNATURE				DATE	6/17/04
Address	Rothwell, Figg, Ernst & Manbeck Suite 800, 1425 K Street, N.W.				
City	Washington	State	D.C.	Zip Code	20005
Country	U.S.A.	Telephone	202-783-6040	Fax	202-783-6031

2917-107-Response to Feb 12 office action - as filed